

Applicant : Hagan Bayley et al.
Serial No. : 09/784,985
Filed : February 15, 2001
Page : 6 of 8

Attorney's Docket No.: 07917-062002 / UMMC 98-03F

REMARKS

Claims 5 to 20, 26, 30 to 34, and 46 to 48, are now pending in this application. Claims 1 to 4, 21 to 25, 27 to 29, and 35 to 45 have been canceled, and claims 12, 13, 26, 30, and 31, have been amended to be independent. Claims 19 and 20 have been amended to depend from claim 15. Claims 32 to 34 have been amended to depend from claim 30. New claims 46 to 48, which mirror claims 32 to 34 but depend from claim 31, have been added. These amendments add no new matter to the application.

Allowed Claims

Applicants acknowledge the Examiner's allowance of claims 15 to 20 in the Office Action at page 11, item 11, and the Examiner's indication, at page 11, item 12, that claims 12, 26, and 30 (and, applicants assume, claim 31) would be allowable if rewritten in independent form. However, applicants respectfully point out that the Office Action Summary recites that claims 5 to 11 and 15 to 20 are allowed. Applicants assume that claims 5 to 11 were omitted from item 11 due to a clerical error, and that these claims are allowed as well.

Objections

Several claims have been objected to as being dependent upon a rejected base claim. The Office Action states (at page 11, item 12):

"Claims 5 - 12, 26, and 30 are objected to as being dependent upon a rejected base claim [.]"

As a preliminary matter, applicants note that claim 5 is actually an independent claim and that the Office Action's above-quoted list of claims to which the present objection is raised is inconsistent with the list recited in the Office Action Summary (which recites "Claim(s) 12, 26, 30, and 31 is/are objected to"). Based on the above, applicants believe claims 5 to 11 were included in, and claim 31 was excluded from, the present objection in error.

Applicant : Hagan Bayley et al.
Serial No. : 09/784,985
Filed : February 15, 2001
Page : 7 of 8

Attorney's Docket No.: 07917-062002 / UMMC 98-03F

Accordingly, applicants believe that claims 12, 26, 30, and 31, were objected to as being dependent upon a rejected base claim. As suggested in the Office Action at page 11, item 12, applicants have amended these claims to be independent and to include all of the limitations of the base claims. Thus, applicants request that the objection to these claims be withdrawn and that the amended claims be allowed.

Double Patenting

Claim 22 was objected to as being a substantial duplicate of claim 24. Applicants have canceled claims 22 and 24, thus obviating the present rejection.

35 U.S.C. § 112, Second Paragraph

The Office Action rejected claims 13 and 14 as allegedly indefinite, stating (at page 2):

Claim 13 has a list of possible amino acids that does not include any of the amino acids listed in claim 12, from which it depends. It is not clear how claim 12 [sic, 13] further limits claim 13 [sic, 12].

In response, applicants have amended claim 13 to be independent. Claim 14 remains dependent upon claim 13. Applicants believe this amendment obviates the present rejection and respectfully request that it be reconsidered and withdrawn.

35 U.S.C. §§ 102 and 103

Claims 1 to 4, 21 to 25, 27, 28, and 35 to 38 were rejected as allegedly anticipated by or, in the alternative, obvious over Walker et al. (Protein Engineering, 7:655-662 (1994); "Walker I") in view of Walker et al. (J. Biol. Chem, 270:23065-23070 (1995); "Walker II") and Tomich et al. (U.S. Patent No. 5,368,712). Claim 39 was rejected as allegedly obvious over Walker I in view of Walker II and Tomich et al. and further in view of Kasianowicz et al. (Mat. Res. Soc. Symp. Proc. 330:217-23 (1994)). Claims 29 and 32 to 34 were rejected as allegedly obvious over Walker I in view of Walker II and Tomich et al. and further in view of Kasianowicz et al. (Abstract, 213th ACS National Meeting, San Francisco, April 13 – 17 (1997)). Claims 33 and 34 were rejected as allegedly obvious over Walker I in view of Walker II and

Applicant : Hagan Bayley et al.
Serial No. : 09/784,985
Filed : February 15, 2001
Page : 8 of 8

Attorney's Docket No.: 07917-062002 / UMMC 98-03F

Tomich et al. and further in view of Kasianowicz et al. (1997) and further in view of Kasianowicz et al. (1994). Claims 40 to 45 were rejected as allegedly obvious over Walker I in view of Walker II and Tomich et al., and further in view of Kasianowicz et al. (1994).

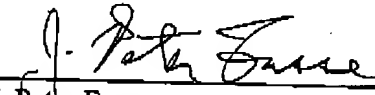
Applicants have canceled claims 1 to 4, 21 to 25, 27 to 29, and 35 to 45, thus obviating all of the rejections listed above.

CONCLUSION

Applicants ask that pending claims be allowed. Enclosed is a \$475 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 07917-062002.

Respectfully submitted,

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